

Hearing:
September 9, 1997

Paper No. 17
EWH/AKP

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUG 4, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Peterson's Guides, Incorporated

Serial No. 74/507,777

G. Franklin Rothwell of Rothwell, Figg, Ernst & Kurz, P.C.
for Peterson's Guides, Incorporated

Brian Weber, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney)

Before Hanak, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Peterson's Guides, Incorporated (applicant) has
appealed the Examining Attorney's final refusal to register
the mark THE EDUCATION CHANNEL in typed form for the
services of "distribution of educational television
programming to cable television systems, and to electronic
and telephonic broadcast and narrowcast systems; and

providing education related information by means of interactive telephone prerecorded messages" in International Class 41, and "providing multiple-user access to a global computer information network for the transfer and dissemination of education related information; computer services, namely providing on-line facilities for real-time interaction with other users concerning educational topics; computer services, namely leasing access time to a computer database in the nature of a community bulletin board in the field of education; and computer services, namely leasing access time to computer databases in the field of education" in International Class 42. Registration was refused under Trademark Act Section 2(e)(1) on the ground that the proposed mark merely describes the applicant's services. Applicant's intent-to-use application was filed on April 7, 1994.

Applicant and the Examining Attorney filed briefs and were present at a hearing held on September 9, 1997.

At the outset one matter should be clarified. While the Examining Attorney has refused registration of THE EDUCATION CHANNEL for both applicant's Class 41 and Class 42 services, the Examining Attorney's arguments on the issue of mere descriptiveness have always been limited to the class 41 services. In both Office Actions and in his brief, the Examining Attorney has failed to explain how applicant's

mark is merely descriptive of the Class 42 services. Hence, we find that the Examining Attorney has simply failed to prove that the mark THE EDUCATION CHANNEL is descriptive of applicant's Class 42 services. Turning to a consideration of applicant's Class 41 services, we note that in support of his refusal to register, the Examining Attorney places a great deal of reliance on two previous Board decisions, stating that "because the [present] applicant's mark is so similar to each of [those in the two cases] and the services so closely related, the Board's analysis therein is particularly relevant in this case." (Examining Attorney's brief page 4). The two cases are In re Weather Channel, Inc., 229 USPQ 854 (TTAB 1985) (THE WEATHER CHANNEL held merely descriptive for television programming services involving weather information) and In re Conus Communications Co., 23 USPQ2d 1717, 1719 (TTAB 1992) (ALL NEWS CHANNEL held "generic for a type of television channel.").¹

While at first blush the mark THE EDUCATION CHANNEL appears quite similar in structure to the marks THE WEATHER CHANNEL and ALL NEWS CHANNEL, there are two significant

¹ In point of fact, the Examining Attorney has also relied upon a third case, namely, In re Kronholm, 230 USPQ 136 (TTAB 1986). However, we have given little consideration to this third case because the Board's brief discussion of mere descriptiveness was dicta. In this regard, we note that the Board stated that "while the resolution of this issue [of nonuse as of the filing date] renders moot the question of mere descriptiveness, we shall also decide that issue." 230 USPQ at 137.

distinctions between the present case and the former two cases which preclude us from finding, on this record, that there is no doubt that THE EDUCATION CHANNEL is merely descriptive of applicant's Class 41 services.

First, in both the Weather Channel and the All News Channel cases, the records were replete with evidence of uses by third parties in a descriptive manner of the terms "weather channel" and "news channel" respectively. In contrast, in this case we have absolutely no evidence of any third-party use in a descriptive manner or otherwise of THE EDUCATION CHANNEL, or anything remotely similar thereto such as "education channel" or "educational channel." While evidence of third party descriptive use is not an absolute requirement in order to hold that a word or phrase is merely descriptive, by the same token, "the absence from this record of evidence of any descriptive use of the term [in question] ... reinforces our view that [applicant's] mark is not merely descriptive." Concurrent Technologies Inc. v. Concurrent Technologies Corp., 12 USPQ2d 1054, 1058 (TTAB 1989).

Second, the Examining Attorney acknowledges that applicant's recited services do not encompass a television channel or a television network. Thus, as applied to the Class 41 services recited in the application, the word "channel" is somewhat ambiguous. In contrast, the services

in the All News Channel case were television broadcasting (i.e. a television channel). Likewise, the services in Kronholm, where COLLEGE CABLE NETWORK was found to be merely descriptive, were "cable television network services." 230 USPQ at 136.

We do acknowledge that the Weather Channel case is more similar to the present case in that the applicant in that case, like the present applicant, was "not directly involved in television broadcasting." 229 USPQ at 855-56. Like the present applicant, the applicant in the Weather Channel case prepared television programming which was in turn disseminated by others (i.e. broadcasters, cable networks etc.). However, in the Weather Channel case, the Examining Attorney presented evidence that the term "weather channel" was the generic name for a type of television station, and that applicant's customers for its television programming services featuring weather information were these very "weather channels." (i.e. television transmission companies featuring a most exclusively weather information). Hence, the Board held that THE WEATHER CHANNEL was merely descriptive for applicant's television programming services featuring weather information because said phrase "merely describes the class of users [weather channels] to which the [applicant's] services are primarily directed." 229 USPQ at 856. In contrast, in the present case we have no

information of record showing that the term "education channel" or anything similar (e.g. "educational channel") are generic terms for any type of channels, networks, transmissions or broadcasts which feature educational subject matter.

Accordingly, based on this very sparse record, we are constrained to find that there exist, at a minimum, doubts as to whether applicant's mark THE EDUCATION CHANNEL is descriptive for the services recited in the application. Of course, if there are doubts on the issue of mere descriptiveness, this Board has a policy of resolving said doubts in favor of the applicant. In re the Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1995).

Decision: The refusal to register is reversed.

E. W. Hanak

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trial Trademark
Trial and Appeal Board

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